

## REMARKS/ ARGUMENTS

The foregoing amendment and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

### Specification

The specification has been amended to indicate the current status of the parent application.

### Title

The title has been amended per the Examiner's suggestion.

### Claim Objection

Claim 14 has been amended to overcome the Examiner's Objection.

### 35 U.S.C. § 103(a) Rejections

Examiner rejected claims 1-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,208,839 (hereinafter "Davani") in view of U.S. Patent 5,732,074 (hereinafter "Spaur").

Claim 1, as amended, includes a limitation of a computer to send a notification via a transmitter so as to be received by a respective remote device, wherein the notification indicates a plurality of message entities have *previously*

been sent to the respective remote device. Neither of Davani nor Spaur disclose such a limitation. As a result, claim 1 is patentable over Davani and Spaur.

Davani discloses a paging system 100 that can transmit a page or message to any one of several wireless devices 118-122 (Col. 2, lines 19-26 and Col. 2, line 64-Col. 3, line 7). The paging system 100 includes a paging terminal 112 that can accept a page request, and that can encode and transmit a message to one of the wireless devices 118-122 (Col. 2, lines 32-47 and 54-59). The paging terminal 112 accepts a page request, and generates a selective call message, which *may include* a canned message (Col. 2, lines 54-59). The selective call message is the page that is sent to the wireless devices 118-122. Since the selective call message *includes* the canned message, numeric display page, or voice message page, *the page and the message are transmitted concurrently*. Therefore, any “notification” disclosed by Davani cannot indicate that a plurality of message entities have *previously* been sent, as in claim 1, since the page and any message are transmitted together. As a result, Davani does not disclose the cited limitation of claim 1.

Spaur is cited by the Examiner to add the limitation of a hypermedia server, which is no longer recited in claim 1, due to the amendment. Spaur discloses a system for communications between a remote computer and a vehicle. Spaur was not cited for the limitation discussed above, and does not disclose a notification to indicate that a plurality of message entities have previously been sent, as in claim 1. Therefore, neither Davani nor Spaur disclose all of the limitations of claim 1, and claim 1 is patentable over Davani and Spaur.

Independent claims 6 and 11, as amended, also include limitations similar to those discussed above regarding claim 1. Therefore, for the same reasons as given above regarding claim 1, claims 6 and 11 are also patentable over Davani and Spaur.

Independent claim 6 also includes a limitation of a plurality of message entities represented by one or more cards arranged in a deck of information. Davani does not disclose this limitation. Specifically, the messages disclosed by Davani are transmitted using conventional paging formats (Col. 2, lines 59-61). Spaur also does not disclose transmitting information as a card or deck.

Independent claim 11 also includes a limitation of building a get-request to send to the hypermedia server, wherein the get-request includes one or more parameters from each of the set of session parameters and the set of request parameters. Neither Davani nor Spaur discuss building a get-request. As a result, the combination of Davani and Spaur does not disclose all the limitations of claim 11.

Dependent claims 2-5, 7-10, and 12-20 depend from the above discussed independent claims 1, 6, and 11, and therefore include all the limitations of those independent claims. Since claims 1, 6, and 11 are patentable over Davani and Spaur, it follows that the dependent claims 2-5, 7-10, and 12-20 are also patentable over Davani and Spaur.

Independent claim 21 includes a limitation of communication facilities receiving a notification and, in response thereto, interface facilities present a notification that message entities have *previously* been recorded in a storage. As mentioned above, Davani discloses a paging system that sends a page and a message concurrently. Therefore, for the same reasons discussed above, Davani does not disclose presenting a notification that message entities have previously been recorded in a storage, as in claim 21. Further, as mentioned above, Spaur discloses only a hypermedia server. As a result, claim 21 is patentable over Davani and Spaur.

Claims 22-33 depend from claim 21, and therefore include all the limitations of claim 21. Since claim 21 is patentable over Davani and Spaur, it follows that the dependent claims 22-33 are also patentable over Davani and Spaur.

### Double Patenting

Examiner has rejected claims 1-33 as being anticipated by claims 1-46 of U.S. Patent No. 6,243,729 (hereinafter "the issued patent"). Applicant understands that this is a statutory type double patenting rejection per the telephone conference with the Examiner on August 2, 2004.

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. [MPEP § 804]

Claim 1 includes limitations not found in any of claims 1-46 of the issued patent. For example, claim 1 of the current application includes a limitation of a computer to receive unsolicited information according to a first transmission protocol in a first form. Claim 1 of the issued patent includes a limitation of a computer to receive unsolicited information, wherein said information is mail, data or other message, and the transmission of said unsolicited information *substantially conforms to Hypertext Transfer Protocol*. There are embodiments of the invention that could fall under the scope of claim 1 of the current application, but not claim 1 of the issued patent. For example, the transmission protocol in the limitation of claim 1 of the current application may be a protocol other than Hypertext Transfer Protocol. If it were, the embodiment employing that other

protocol would *not* be within the scope of claim 1 of the issued patent. Therefore, claim 1 of the current application is patentably distinct from claim 1 of the issued patent. Further, since the limitation of claim 1 of the issued patent is *narrower* than the limitation of claim 1 of the current application, none of the claims that depend on claim 1 of the issued patent subject claim 1 of the current application to a statutory double patenting rejection.

The remaining claims of the issued patent are either of the wrong type (i.e., the method claims 9-19, 30-36, 39-40, 43, 44, and 46), or too dissimilar to claim 1 of the current application (i.e., claims 23-29, 41-42, and 45 claiming a handheld device) to serve as a basis for a statutory double patenting rejection.

Independent claim 6 of the current application includes a limitation not included in any of the claims 1-46 of the issued patent. Specifically, claim 6 of the current application includes a limitation of a plurality of message entities represented by one or more cards arranged in a deck of information. None of claims 1-46 of the issued patent include this limitation. Further, claims 7-10 and 15 depend from claim 6, and include all the limitations of claim 6. Since claim 6 includes a limitation not found in the claims of the issued patent, the claims that depend from it also include that limitation, and therefore cannot be subject to a statutory double patenting rejection based on the issued patent.

Independent claim 11 of the current application includes a limitation of a computer to build a get-request to send to a hypermedia server. None of the claims 1-46 of the issued patent discuss a get-request. As a result, claim 11, and the dependent claims 12-20 cannot be subject to a statutory double patenting rejection based on the issued patent.

Independent claim 21 includes a limitation of navigation facilities that traverse Uniform Resource Locator (URL) links. None of the claims 1-46 of the

issued patent discuss URL links. As a result, claim 21 and the dependent claims 22-33 cannot be subject to a statutory double patenting rejection based on the issued patent.

CONCLUSION

Applicants respectfully submit the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Arlen Hartounian at (408) 720-8300.

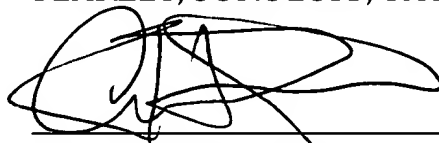
Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: \_\_\_\_\_

8/05/04



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